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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,332	11/18/2003	Toshiyuki Tanaka	6639P008	8285

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EXAMINER

CHANG, YEAN HSI

ART UNIT PAPER NUMBER

2835

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/717,332

Applicant(s)

TANAKA ET AL.

Examiner

Yean-Hsi Chang

Art Unit

2835

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-14 and 18-23 is/are rejected.
- 7) ☒ Claim(s) 5-7, 15-17 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>See attachment</u> . | 6) <input type="checkbox"/> Other: _____ |

2/18/04, 7/15/05, and 9/2/05.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-8, 12-18 and 22-23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/717,850 ('850). Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim same subject matters in different manner and with some different terminologies, such as: a first body vs. a first body casing, a second body vs. a second body casing, a pointing device vs. a cursor control device, and a coupling member vs. a display support mechanism, except case '850 fails to teaches the cursor control device comprising a pointer guide and at least one button. It would have been obvious to one having ordinary skill in the art and well known in the art that a cursor control device may

Art Unit: 2835

comprising a pointer guide to control a position of a pointer displayed on a display and at least one button adjacent to the pointer guide.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 states that the coupling member is coupled to the first body which is in contradiction with the statement "a coupling member coupled to the second body " as stated in claim 3, from which it depends.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 2835

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4 and 8-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Nagamine (US 2003/0203747 A1).

Nagamine teaches an electronic device (10, fig. 3) comprising: a body case (20+30), a display (11) mounted on the body case (shown in fig. 2A) for horizontal rotation and translation over the body case, the display substantially covering a footprint of the body case (shown in fig. 1B), and a pointing device (on 20a, shown in fig. 2A, not labeled) situated on the body case, the pointing device comprising a pointer guide and at least one button (shown in fig. 3, not labeled), and being accessible regardless of the rotation and the translation of the display (shown in figs. 2A-2C) (claims 1 and 8); wherein the body case includes a first body (20) and a second body (30), and the pointing device is integrated in the first body (shown in fig. 2A) (claim 2); a hinge (13) rotationally coupled to the first body and the second body (shown in fig. 3), and a coupling member (40) coupled to the second body and the display (fig. 4A), the coupling member being adapted to horizontally rotate and translate the display (claim 3); wherein the coupling member is a shaft (portion 44) coupled between a fastening element (44a) coupled to the display (shown in figs. 4A and 4C) and a securing element (44b) slidably coupled to the second body (also shown in figs. 4A and 4C) (claim 4); and a camera (17) positioned on the second body (the camera being positioned on the display which is on the second body as shown in fig. 3) (claim 9).

Art Unit: 2835

7. Claims 12-14 and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Nagamine.

Nagamine teaches an electronic device (10, fig. 3) comprising: a body case (20+30) including a first body (20) and a second body (30), a hinge (13) coupling the first body and the second body (shown in fig. 3), the hinge configured to enable the second body to be vertically rotated from the first body, a display (11) rotatably coupled to the body case (shown in fig. 2A) and adapted to be rotated and translated over the body case (shown in figs. 2 and 4B), the display having a flat panel display (see fig. 3 and section [0063]), and a pointing device (on 20a, shown in fig. 3, not labeled) positioned at the first body, the pointing device comprising a pointer guide and at least one button (shown in fig. 3, not labeled), and being accessible and remaining uncovered by the display for all positions of the display (shown in figs. 2A-2C) (claims 12 and 18); wherein the pointing device being integrated in the first body (shown in fig. 3) (claim 13); a coupling member (40) coupled to the second body and the display (fig. 4A), the coupling member being adapted to horizontally rotate and translate the display (shown in figs. 2A-2C and 4B) (claim 14); and a camera (17) positioned on the second body (the camera being positioned on the display which is on the second body as shown in fig. 3) (claim 19).

Claim Rejections - 35 USC § 103

Art Unit: 2835

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagamine in view of Santoh (US 6,636,204 B2).

Nagamine discloses the claimed invention except a holder for a writing instrument arranged on the second body.

Santoh teaches an electronic device (fig. 3A) comprising: a second body (1) of a body case (1+2), including a holder (3) for a writing instrument (5).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Nagamine with the holder for a writing instrument taught by Santoh for providing a convenient input tool for the user.

10. Claims 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagamine in view of Castañeda et al. (US 5,940,153).

Nagamine discloses the claimed invention except a cover operating as a lens to magnify an image displayed on the display.

Castañeda teaches a cover lens (110, fig. 1) for magnifying an image displayed on a display (130).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Nagamine with the cover lens taught by Castañeda to magnify an image displayed on the display for the user's convenience.

Allowable Subject Matter

11. Claims 22-23 are allowable if the double patenting rejection is overcome.
12. Claims 5-7, 15-17 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
13. The following is a statement of reasons for the indication of allowable subject matter: The best prior art of record, Nagamine (US 2003/0203747 A1), fails to teach or fairly suggest an electronic device comprising at least: a display mounted on a body case of the electronic device, being horizontally rotated by a coupling member between a first position where the display covers a keyboard positioned at a first body of the body case, and a second position where the display exposes at least part of the keyboard as set forth in claim 5; a keyboard associated with a first body of the body case, being covered by the display when the electronic device is placed in a first position and being partially covered by the display when the electronic device is placed in a second position as set forth in claim 15; and the display to cover (i) at least one-half of a footprint of the first body and at least one-half of a footprint of the second body when the electronic device is placed in a TABLET position, and (ii) none of the first body

Art Unit: 2835

and at least one-half of a footprint of the second body when the electronic device is placed in a FREE-STANDING position and a pointing device positioned at an edge of the first body, being accessible and remaining uncovered by the display for both positions as set forth in claim 22. Claims 6-7, 16-17, and 23-24 are dependent claims from claims 5, 15, and 22, respectively.

Correspondence


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yean-Hsi Chang whose telephone number is (571) 272-2038. The examiner can normally be reached on 07:30 - 16:00, Monday through Friday (except every other Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the Art Unit phone number is (571) 272-2800, ext. 35. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2835

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-8558.

Yean-Hsi Chang
Primary Examiner
Art Unit: 2835
October 4, 2005



YEAN-HSI CHANG
PRIMARY EXAMINER